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OFFICE OF PETITIONS

WENDEROTH, LIND & PONACK, L.L.P.
1030 15th Street, N.W.,
Suite 400 East
Washington DC 20005-1503

In re Patent No. 7,786,307 :
Herold et al. : DECISION ON REQUEST FOR
Issue Date: August 31, 2010 : RECONSIDERATION OF
Application No. 10/587,150 : PATENT TERM ADJUSTMENT
Filed: July 24, 2006 :
Attorney Docket No. 2006_0980A :
Title: AMINO ALCOHOL :
DERIVATIVES AND THEIR ACTIVITY :
AS RENIN INHIBITORS :

This is a decision on the petition filed on September 22, 2010, which is being treated as a petition under 37 CFR 1.705(d) requesting that the patent term adjustment indicated on the above-identified patent be corrected to indicate that the term of the above-identified patent is extended or adjusted to five hundred fifty (550) days.

The petition to correct the patent term adjustment indicated on the above-identified patent is **DISMISSED**.

Patentees dispute the 120 day reduction for the submission of the petition filed March 11, 2010. Patentees contend that pursuant to 37 CFR 1.704(e) a reduction for the submission of a request for application for patent term adjustment under 37 CFR 1.705(b) will not be considered a failure to engage in reasonable efforts to conclude prosecution under 37 CFR 1.704(c)(10).

Patentees' argument has been considered but not determined to be persuasive. A review of the record shows that the 120 day reduction was entered based upon the submission of the "Addendum to Statement Under 37 CFR §3.73(b)" filed on March 11, 2010.

37 CFR 1.704(c) provides that:

Circumstances that constitute a failure of the applicant to engage in reasonable efforts to conclude processing or examination of an application also include the following circumstances, which will result in the following reduction of the period of adjustment set forth in § 1.703 to the extent that the periods are not overlapping:

37 CFR 1.704 (c)(10) provides:

(10) Submission of an amendment under § 1.312 or other paper after a notice of allowance has been given or mailed, in which case the period of adjustment set forth in § 1.703 shall be reduced by the lesser of:

i) The number of days, if any, beginning on the date the amendment under § 1.312 or other paper was filed and ending on the mailing date of the Office action or notice in response to the amendment under § 1.312 or such other paper;

or

(ii) Four months;

The submission filed March 11, 2010 warrants a 120 day reduction. The submission of the Addendum to Statement Under 37 CFR §3.73(b) after the mailing of the Notice of Allowance is a failure to engage in reasonable efforts to conclude prosecution. Accordingly, pursuant to § 1.704(c)(10), the patent term adjustment was properly reduced by the lesser period of four months or 120 days. The 120 day period is calculated beginning on March 11, 2010 and ending on August 31, 2010 the date the patent issued. As such the 120 day reduction will not be removed. See *Clarification of 37 CFR 1.704(c)(10) - Reduction of Patent Term Adjustment for Certain Types of Papers Filed After a Notice of Allowance*, 1247 OG 111 (June 26, 2001).

In view thereof, the patent is entitled to an overall adjustment of 430 days.

Nothing in this decision shall be construed as a waiver of the requirement of 35 U.S.C. 154(b)(4) that any civil action by an

applicant dissatisfied with a determination made by the Director under 35 U.S.C. 154(b)(3) be filed in the United States District Court for the District of Columbia within 180 days after the grant of the patent.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

Telephone inquiries specific to this matter should be directed to Petitions Attorney, Charlema Grant at (571) 272-3215.



Anthony Knight
Director
Office of Petitions